<u>**REMARKS/ARGUMENTS**</u>

Claims 1, 2, 3 and 5 remain in the application. Reconsideration of this application is respectfully requested.

<u>*Claim Objection:*</u>
Claims 1-3 and 5 were objected to because claim 1-3 and 5 recite "…monitoring only background noise levels…" or monitoring subsequent background audio level alone".

The Office Action refers to Applicant's specification page 4, lines 12-19 as not being supportive of this language. However, Applicant respectfully refers the Examiner to page 2, lines 18-21 of the specification which recites:

> In accordance with the present invention, an intelligent automatic volume control technique takes a measurement of the environment (background noise) at the time a user manually selects the volume.

Thus, the audio environment defined on page 4, lines 12-19 means only the background noise. Additionally, FIG. 2 clearly shows only BACKGROUND NOISE ENVIRONMENT being sampled by microphone (214). Also, in the flowchart of FIG. 1 all of the steps deal with background levels alone. Thus, the specification sufficiently supports the use of the word "alone" and "only" within the claims. Applicant respectfully requests the objection be withdrawn.

<u>*Specification*</u>
The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.

Again, claims 1-3 and 5 were objected to for the steps of "monitoring only background noise levels" and "… monitoring subsequent background audio level alone." As argued above, Applicant respectfully maintains that the specification sufficiently supports the use of the terms "only" and "alone" via FIG. 2 microphone (214) measuring BACKGROUND NOISE ENVIRONMENT; FIG. 1 and at least page 2, lines 18-21. Applicant requests that the objection to the specification now be withdrawn.

Claim rejections 35USC112
Claims 1-3 and 5 were rejected under 35USC112, first paragraph due to the recitation of the words "only" and "alone" referring to page 4, lines 12-19.

Applicant respectfully traverses. As argued above, Applicant asserts that the audio environment being sampled has sufficiently been described as being Background Noise only via at least page 2, lines 18-21, FIG. 2 microphone (214) measuring BACKGROUND NOISE; and FIG. 1. Accordingly the rejection under 35 USC 112, first paragraph is overcome.

Claim Rejection - 35 U.S.C. § 103:
Claims 1-3 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Helms (US Patent 5,666,426) in view of Cooper (US Patent 5,790,671).

Neither reference taken individually or in combination teaches that which is claimed by Applicant's invention. Both Helms and Cooper consider BOTH the desired signal and noise and do not consider background noise alone as claimed by Applicant's independent claims.

The Helms reference teaches measuring an amplified output signal (the desired signal) and the background signal simultaneously. The Helms reference requires measuring both the desired (amplified output) signal and the background signal. As seen in FIG. 1, steps 32, 34 and col. 4, lines 1-7, as well as the independent claims, the Helms reference samples not only the background noise but also the amplified output signal simultaneously. This is done out of necessity, since the signal that Helms is controlling is constantly playing out, such as from a car radio.

The Helms technique is not optimal, particularly in the case of two-way radios (claims 1 and 5), as the Helms technique can not sense background noise alone. All of Applicant's claims (1, 2, 3 and 5) are directed to measuring the background levels only – there is no recitation or requirement of measuring the desired/amplified output signal. The Helms reference is not applicable to the two-way environment, specifically called out in claims 1 and 5. The very

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nature of a two-way radio is that the speaker is turned OFF when the microphone is

active. Hence, when the microphone samples the background audio levels in Applicant's

invention, audio from the speaker is not picked up. Applicant samples only the background

noise - and not what is coming out of the speaker.

The Examiner concedes, on page 4 of the Office Action, that Helms fails to disclose

switchably engaging a microphone, but interprets this as "selectively engaging a microphone"

referring to col. 4, lines 21-32 of Cooper. However, Cooper specifically recites in col. 4, lines

21-32:

> The ambient noise level checked in step S101 is determined in accordance with either the volume setting (determined by the position of the volume knob) or a direct sampling of ambient noise using the digitized microphone audio input 22. With respect to determining the volume setting, it is assumed that a high volume setting is indicative of a high ambient noise level. The microprocessor accesses an audio parameter table including the audio parameters stored in the EEPROM 16 and/or flash memory 18 in accordance with the volume setting or the sampled ambient noise level.

There is nothing in this passage about selectively engaging a microphone or switchably engaging

a microphone.

Additionally, as stated above, the "ambient noise" of Cooper includes BOTH the

background noise and the speaker output signals. In col. 1, lines 15-20 Cooper states:

"increasing the volume adds to the pre-existing high ambient noise level, which could result in

other noise sources increasing their volume, thereby further aggravating the problem." Thus,

Cooper's own volume (speaker) adds to the pre-existing high ambient noise. Accordingly,

Cooper teaches away from switchable or selectable since Cooper considers volume level as a

component of the sampled ambient. Much like Helms, Cooper is using BOTH the desired and

the noise signal in determining ambient level while Applicant's have a switchable microphone

and only measure background noise.

Accordingly, the rejection under 35 USC 103 is overcome.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Applicants believe that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicants.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

The Commissioner is hereby authorized to charge Deposit Account 502117, Motorola, Inc, with any fees which may be required in the prosecution of this application.

Respectfully submitted,

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